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10/526,683

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Yves Desarzens

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EXAMINER

GEORGE, TARA R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,683	Applicant(s) DESARZENS ET AL.	
	Examiner TARA R. GEORGE	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,8,10,11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,8,10,11,13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Weigand et al. (US 4023572).

With respect to claim 1, Weigand discloses an acetabular reamer for surgical use, the reamer comprising (a) a hemispherical, hollow dome extending from an apex to a lower edge (at 102) defining an equilateral plane (see fig. 1); and (b) an interface structure comprising at least one cross-bar (10) fixedly attached to the inside of the dome at intermediate locations (at 11) between the equatorial plane and the apex so that the interface structure is positioned inwardly from the edge and within the dome (see figs. 1 and 2).

As for claim 7, wherein the cross-bar is fixedly attached to the inside of the dome along a latitudinal plane (see fig. 1).

With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Weigand et al. which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference “teach” what the

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subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weigand et al. (US 4023572), as applied to claim 1, in view of McCallum et al. (US 2003/0220647).

As for claims 3-5, Weigand teaches the claimed invention except for wherein at least one substantial section is removed; a plurality of sections of the dome are removed; and wherein the removed sections are equally spaced about the equator of the dome. McCallum teaches wherein a plurality of sections (13 and 14) of the dome are removed; and wherein the removed sections are equally spaced about the equator of the dome (see figs. 2 and 3) in order to reduce a static insertion profile of the reamer, as compared to a dynamic profile, in order to facilitate surgery which is relatively less invasive than a surgery performed with a comparable reamer not having the removed

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sections (see para. 6 and 24). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Weigand in view of McCallum in order to reduce the insertion profile of the reamer, providing a less invasive tool.

As for claim 8, wherein the removed section renders the dome asymmetrical, it is noted that it is inherent that if an odd number of sections were to be removed, the dome would not be symmetrical.

As for claim 10, Weigand teaches the claimed invention except for wherein the interface structure comprises at least two cross-bars having their respective ends fixedly attached to the inside of the dome spaced 90 degrees from each other at locations between the equatorial plane and the apex. McCallum teaches wherein the interface structure comprises at least two cross-bars (90, 95) having their respective ends fixedly attached to the inside of the dome spaced 90 degrees from each other at locations between the equatorial plane and the apex in order to provide a more stable attachment to a reamer spindle with a larger interface surface. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Weigand in view of McCallum in order to provide a more stable attachment to a reamer spindle with a larger interface surface.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weigand et al. (US 4023572), as applied to claim 1, in view of Sayler (US 6250858).

As for claim 11, Weigand teaches the claimed invention except for wherein the cross-bar comprising the interface structure has a central centering boss. Sayler

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teaches a boss (18) in order to center and coaxially align a reamer spindle (10) with the reamer (see col. 3 lines 1-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Weigand in view of Sayler because the use of a boss to center and coaxially align a reamer spindle with a reamer is a known technique. It also would have been obvious to one of ordinary skill in the art at the time of the invention to construct the interface structure with the boss rather than the reamer spindle, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weigand et al. (US 4023572), as applied to claim 1, in view of Nordin (US 3847154).

With respect to claim 13, Weigand further teaches (c) a reamer spindle having a coupling, wherein the reamer and the spindle are detachably attachable to each other via the inset interface structure and the coupling (see figs. 7-9). Weigand teaches the claimed invention except for the reamer spindle being angled. Nordin teaches an angled drive shaft (see fig. 2) in order to more easily center the drive shaft with respect to the surgical site (see col. 1 lines 14-17). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Weigand in view of Nordin in order to more easily center the drive shaft with respect to the surgical site.

Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lechot (US 6129732) in view of Weigand et al. (US 4023572).

With respect to claim 14, Lechot teaches an acetabular reamer for surgical use comprising (a) a hemispherical, hollow dome (1) extending from an apex to a lower edge (see fig. 1) defining an equatorial plane; and (b) an interface structure (note 3) comprising a proximal end extending to a distal end supporting at least two radial spokes (4) extending therefrom in a radial spokes plane within the dome (see fig. 1). Lechot does not appear to state that said interface structure comprises a shaft having a proximal end secured to an inner surface of the dome at the apex. Weigand teaches a tool/tool support relationship wherein shaft (409) has a proximal end secured to an apex of a dome (400) in order to provide a coaxial and stable relationship between the reamer and the spindle. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify 3 of Lechot such that it extends from the dome of the reamer in view of Weigand in order to provide a stable and coaxial relationship between a reamer and a spindle.

As for claim 15, Lechot further teaches wherein the interface structure comprises four radial spokes extending from the distal end of the shaft along the radial spoke plane (see fig. 1).

As for claim 16, Lechot further teaches wherein the four radial spokes are disposed at 90 degrees with respect to each other (see fig. 1).

As for claim 17, Lechot further teaches wherein the radial spokes is parallel to the equatorial plane so that the interface structure is completely within the dome (see fig. 1).

Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lechot (US 6129732) in view of Weigand et al. (US 4023572), as applied to claim 14, in further view of McCallum et al. (US 2003/0220647).

As for claims 18-20, Lechot and Weigand teaches the claimed invention except for wherein at least one substantial section is removed; a plurality of sections of the dome are removed; and wherein the removed sections are equally spaced about the equator of the dome. McCallum teaches wherein a plurality of sections (13 and 14) of the dome are removed; and wherein the removed sections are equally spaced about the equator of the dome (see figs. 2 and 3) in order to reduce a static insertion profile of the reamer, as compared to a dynamic profile, in order to facilitate surgery which is relatively less invasive than a surgery performed with a comparable reamer not having the removed sections (see para. 6 and 24). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lechot and Weigand in view of McCallum in order to reduce the insertion profile of the reamer, providing a less invasive tool.

As for claim 21, wherein the removed section renders the dome asymmetrical, it is noted that it is inherent that if an odd number of sections were to be removed, the dome would not be symmetrical.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lechot (US 6129732) and Weigand et al. (US 4023572) in view of McCallum et al. (US

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2003/0220647), as applied to claim 14, and further in view of in view of Nordin (US 3847154).

With respect to claim 22, Lechot, Weigand and McCallum further teaches (c) a reamer spindle having a coupling, wherein the reamer and the spindle are detachably attachable to each other via the inset interface structure and the coupling (see Weigand figs. 7-9). Lechot, Weigand and McCallum teaches the claimed invention except for the reamer spindle being angled. Nordin teaches an angled drive shaft (see fig. 2) in order to more easily center the drive shaft with respect to the surgical site (see col. 1 lines 14-17). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Lechot, Weigand and McCallum in view of Nordin in order to more easily center the drive shaft with respect to the surgical site..

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 4, 5, 7, 8, 10, 11 and 13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TARA R. GEORGE whose telephone number is (571)272-3402. The examiner can normally be reached on M-F from 8am-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. R. G./

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733